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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,789	01/25/2006	Dinesh Narendra Rele	HM/15-22928/A/PCT	7615

324 7590 08/06/2007  
CIBA SPECIALTY CHEMICALS CORPORATION  
PATENT DEPARTMENT  
540 WHITE PLAINS RD  
P O BOX 2005  
TARRYTOWN, NY 10591-9005

EXAMINER

YOUNG, SHAWQUA

ART UNIT PAPER NUMBER

1626

MAIL DATE DELIVERY MODE

08/06/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/565,789

Applicant(s)

RELE ET AL.

Examiner

Shawquia Young

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 8-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 6/8/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

Claims 1-19 are currently pending in the instant application.

### **I. *Priority***

The instant application is a 371 of PCT/EP/04/51533, filed on July 19, 2004 and claims benefit of Foreign Application EPO 03102324.5, filed on July 29, 2003.

### **II. *Information Disclosure Statement***

The information disclosure statement (IDS) submitted on June 8, 2006 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

### **III. *Restriction/Election***

#### ***A. Election: Applicant's Response***

Applicants' election with traverse of Group I in the reply filed on July 13, 2007 is acknowledged. The traversal is on the ground(s) that: (1) the compounds are novel and as such constitute a special technical feature linking the elected portions of claims 1-7 and 18-19 with those portions of the method claims 9-17 in which the elected compounds are employed.

All of the Applicants' arguments have been considered but have not been found persuasive. It is pointed out that the restriction requirement is made under 35 U.S.C. 121. 35 U.S.C. 121 gives the Commissioner (Director) the authority to restrict applications to several claimed inventions when those inventions are found to be independent and distinct. The Examiner has indicated that more than one independent

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and distinct invention is claimed in this application and has restricted the claimed subject matter accordingly. Applicants request that the portions of claims 9-17 which employ the elected compound claims be rejoined upon finding the elected compound claims 1-7 and 18-19 allowable.

The Restriction Requirement detailed the reasons for restriction between the groups. Different search considerations are involved (i.e., class/subclass searches, databases searches, etc.) for each of the groups listed. The inventions are classified into classes 514 and 564. However, each Class 514 and 564 encompasses numerous patents and published applications. For instance, Class 514 contained 165,171 patents and published applications. Therefore it would constitute a burden on the Examiner and the Patent Office's resources to examine the instant application in its entirety.

The Examiner wants to point out that there was a "Advisory of Rejoinder" paragraph in the Restriction Requirement mailed on June 19, 2007 on pages 4-6. It addressed the matter that if the product claims are found allowable then the process claims will be rejoined.

Subject matter not encompassed by elected Group I are withdrawn from further consideration pursuant to 37 CFR 1.142 (b), as being drawn to nonelected inventions.

#### **IV. Rejections**

##### ***Claim Rejections - 35 USC § 102***

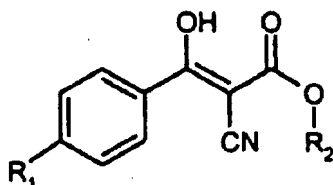
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by *Murray, et al.* (US 5,686,228). The instant invention claims a product with



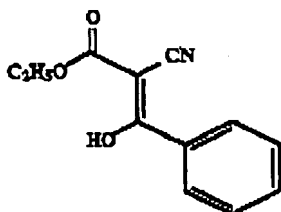
the formula

wherein **R<sub>1</sub>** is hydrogen, C<sub>1</sub>-C<sub>20</sub> alkyl, C<sub>1</sub>-

C<sub>20</sub> alkoxy, CF<sub>3</sub>, C<sub>6</sub>-C<sub>10</sub> aryl or a radical of formula (1a<sub>1</sub>) and **R<sub>2</sub>** is hydrogen or C<sub>1</sub>-C<sub>20</sub>

alkyl.

The *Murray, et al.* reference teaches the species with the formula



(See PR-06, column 8) and its use as a possible antifoggant.

This species of compound anticipates the genus compound of the instant invention,

wherein the genus structure and its definitions are stated above.

### ***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 and 18-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The “derivatives” of the compounds of Claims 1-7 and 18-19 are not defined in the specification so as to know the structures of the compounds that are included and/or excluded by the term. Therefore, the specification lacks adequate support for Claims 1-7 and 18-19.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 and 18-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-7 and 18-19 are indefinite for the reasons set forth above under 35 U.S.C. 112, first paragraph. Claims 1-7 and 18-19 are drawn to “3-aryl-2-cyano-3-hydroxy-acrylic acid derivatives of formula....”. However, the “derivatives” of the compounds of Claims 1-7 and 18-19 are not defined in the claims so as to know the metes and bounds of the claims. Therefore, the claims are indefinite.

**V. Objections**

***Claim Objection-Non Elected Subject Matter***

Claims 1-7 and 18-19 are objected to as containing non-elected subject matter. To overcome this objection, Applicant should submit an amendment deleting the non-elected subject matter.

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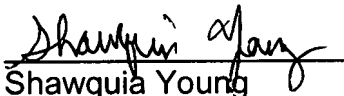
Claim 1 is objected to because of the following informalities: The claim begins with a number and not a capital letter. Each claim begins with a capital letter and ends with a period (MPEP 608.01 (m)). Appropriate correction is required.

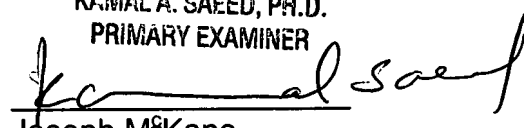
## VI. Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 6:00 AM-2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph M<sup>re</sup>Kane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Shawquia Young  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

KAMALA A. SAEED, PH.D.  
PRIMARY EXAMINER  
  
for Joseph M<sup>re</sup>Kane  
Supervisory Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600